

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/470,944	12/22/99	GUNDLING	0050-05-01

023492
ABBOTT LABORATORIES
DEPT. 377 - AP6D-2
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ABBOTT PARK IL 60064-6050

HM12/0607

EXAMINER
SPIEGLER, A

ART UNIT	PAPER NUMBER
1656	

DATE MAILED:

06/07/01

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/470,944

Applicant(s)

GUNDLING, GERARD

Examiner

Art Unit

Alexander H. Spiegler

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 May 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☐ they raise the issue of new matter. (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: None.
- Claim(s) objected to: None.
- Claim(s) rejected: 1-16.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other:

Continuation of 3.

NOTE: The amendments to the claims to recite that "the nucleic acid bonds with the metal oxide" would raise new issues under 35 USC 103. The newly amended claims recite that the nucleic acid bonds directly with the metal oxide, whereas the currently pending claims require only that the metal oxide particles are capable of forming a nucleic acid/metal oxide complex. This claim amendment would require a search of a specific bond between the nucleic acid and the metal oxide, which was not previously required, and therefore would require further search and consideration of the prior art.

Continuation of 6.

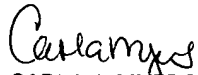
for the reasons of record, in view of the non-entry of the amendment filed on May 22, 2001. Applicant submits that the Office Action of Paper No. 10 misconstrues the Umatsu et al. reference, and asserts that it is not possible to make magnetic silica (of which the Umatsu reference uses with superparamagnetic metal oxide) and therefore, the superparamagnetic metal oxide is present to make the particles magnetic. Applicant also questions whether the metal oxide is also present to make the nucleic acid bond to the particle, and asserts that it is exceedingly unlikely because it would leave no express or implicit use for the silica. These arguments are deemed not persuasive because applicant is relying solely on speculation and personal opinion to support his position, and provides no evidentiary or declaratory data to support these assertions. That is, applicants have not provided any evidence to support the contention that the particles of Umatsu do not comprise nucleic acids bound, directly or indirectly, to the metal oxide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-0806. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Alexander H. Spiegler
June 6, 2001


CARLA J. MYERS
PRIMARY EXAMINER